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ON

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/656,663	09/07/2000	Joseph E. Kaminkow	0112300/012	1991

29159 7590 06/04/2003

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EXAMINER

JONES, SCOTT E

ART UNIT PAPER NUMBER

3713

DATE MAILED: 06/04/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/656,663

Applicant(s)

KAMINKOW ET AL.

Examiner

Scott E. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 131-221 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 131-221 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on November 12, 2002 and the response the restriction requirement filed March 20, 2003. In the amendment, Applicant reinstates claims 34-64, 69-115, and 118-130 (The claims are now numbered 131-221). Applicant amends claims 131, 142, 144, 147, 150, 153, 156, 159, 162, 167, 171, 177, 179, 182, 185, 188, 191, 194, 197, 202, 203, 204, 205, 206, 207, 208, 209, 210, 215, 216, 217, 218, 219, 220, and 221 and responds to the claim rejections. Regarding the response to the restriction requirement, Applicant elects Group II, Claims 131-221 without traverse.

Election/Restrictions

2. Applicant's election without traverse of Group II in Paper No. 17 is acknowledged.
3. Claims 65-68 and 116-117 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 17.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 131-143, 162-166, 167-178, 197-202, 210-211, and 215 are rejected under 35 U.S.C. 102(e) as being anticipated by Weiss (U.S. 6,309,299).

Weiss discloses a traditional gaming machine enhanced and blended with a battleship game. Weiss additionally discloses:

Regarding Claims 131, 142, 162, 167, 177, 197, 199, 202, 210, and 215:

- operating a game upon a wager by a player (Figure 5 and column 3, lines 34-48);
- displaying a target/pitfall (ships located on the x-y grid) (Figure 1);
- displaying a plurality of non-targets/non-pitfalls (grid locations c-2 and e2) including at least two non-targets/non-pitfalls which are each a same predetermined proximity/distance from said target/pitfall (Figure 1);
- selecting either said target/pitfall or one of the non-targets/non-pitfalls (Figure 2 and column 2, lines 15-24); and
- generating a sound effect associated with said predetermined proximity/distance when one of said non-targets/non-pitfalls selected is within said predetermined proximity/distance (Column 4, lines 19-20).

Regarding Claims 132 and 168:

- the non-targets/non-pitfalls which are within said predetermined proximity from said target are spatially related to said target (Figure 1). Grid locations c-2 and e2 are each one space away from the target.

Regarding Claims 133 and 169:

- the non-targets/non-pitfalls which are within said predetermined proximity from said target are numerically related to said target (Figure 1).

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Regarding Claims 134 and 170:

- at least one non-target/non-pitfall within said predetermined proximity from said target/pitfall is located numerically above said target/pitfall, and at least one non-target/pitfall within said predetermined proximity from said target/pitfall is located numerically below said target/pitfall (grid locations c-2 and e2) (Figure 1).

Regarding Claims 135, 143, 171, 178, 198 and 211:

- said sound effect includes a message describing the location of said target/pitfall (Column 2, lines 20-24).

Regarding Claims 136 and 172:

- the plurality of non-target/non-pitfall includes at least one non-target/non-pitfall (32) which does not have an associated sound effect (Figure 1).

Regarding Claims 137, 173 and 200:

- providing an award to a player when said target/pitfall is selected (Figure 3 and column 2, lines 15-24).

Regarding Claims 138, 163, 174, and 201:

- the processor causes the speaker to generate a second different sound effect when said target is selected (Column 4, lines 18-20). Bombs in flight will sound different than a bomb in flight that lands and hits a target.

Regarding Claim 139:

- the processor causes the speaker to generate a third different sound effect when said award is provided to the player. Inherently, bells, chimes, dings, sirens, or some other form of sound is used in the game machine to indicate a win.

Regarding Claims 140, 164, and 175:

- the target or one of the non-targets is processor selected (Column 2, lines 1-25).

Regarding Claims 141, 165, 166, and 176:

- the target or one of the non-targets is player selected (Column 5, lines 32-46).

6. Claims 147-152, 182-187, 204-205, 209, and 217-218 are rejected under 35

U.S.C. 102(e) as being anticipated by Tsukahara (U.S. 6,416,411).

Tsukahara discloses a gaming machine having random sound effects so that a player does not become bored playing the same game (Abstract, figures 3, 5, 6, and column 2, lines 26-57).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 144-146, 179-181, 203, and 216 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss (U.S. 6,309,299) in view of Lebensfeld et al. (U.S. 6,311,982).

Weiss discloses that as discussed above regarding claims 131-143, 162-166, 167-178, 197-202, 210-211, and 215. Weiss seems to lack explicitly disclosing:

Regarding Claims 144, 179, 203, and 216:

- a second sound effect, which is different from the first sound effect associated with said second predetermined proximity.

Lebensfeld et al., like Weiss, teaches of an electronic game. In particular, Lebensfeld et al. teaches of a "hot/cold" or "near/far" type hide and find toy game. As a player gets closer to

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the toy a stronger audible signal is generated to a player's receiver and vice versa (Column 2, line 50-Column 3, line 67). It would have been obvious at the time of applicant's invention to incorporate the traditional "hot/cold" children's game feature in Weiss' battleship game. One would be motivated to do so because this would enable a player playing Weiss' game to have a better idea of where a ship is located to fire the next missile, etc.

9. Claims 156-161, 191-196, 198, 200, 201, 208, and 221 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss (U.S. 6,309,299) in view of The Price is Right Three Strikes Game.

Weiss discloses that as discussed above regarding claims 131-143, 162-166, 167-178, 197-202, 210-211, and 215. However, Weiss seems to lack explicitly disclosing:

Regarding Claims 156, 191, 194, 208, and 221:

- counting the number of times one of the non-targets within said predetermined proximity from said target is selected, and upon reaching said predetermined number, causing the speaker to generate said sound effect.

The Price is Right Three Strikes Game teaches a game wherein a player has an opportunity to draw numbers out of a bag and determine which digit of the price of the car that number is. However, if a player draws three strikes the game is over. It would have been obvious to one having ordinary skill in the art to incorporate the feature taught in The Price is Right Three Strikes Game in Weiss' gaming machine. One would be motivated to do so because this would provide a player only three opportunities to sink a ship in Weiss' game making the game very competitive.

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10. Claims 153-155, 188-190, 206-207, and 219-220 are rejected under 35 U.S.C. 103(a) as being unpatentable over The Price is Right Three Strikes Game.

The Price is Right Three Strikes Game discloses a game wherein a player has an opportunity to draw numbers out of a bag and determine which digit of the price of the car that number is. However, if a player draws three strikes the game is over. The Price is Right Three Strikes Game discloses all of the claim limitations except:

Regarding Claims 153 and 188:

- a processor operable to control a game upon a wager by a player.

Regarding Claims 154 and 189:

- the target/pitfall or one of the non-targets/non-pitfalls is processor selected.

Regarding Claims 206, 207, 219, and 222:

- operating a game upon a wager by a player.

However, it would have been obvious to one having ordinary skill in the art to incorporate The Price is Right Three Strikes Game in a gaming machine requiring a wager and having a processor. Gaming machine processors and processor selections are well known. One would be motivated to do so because the game is very popular and would give players an opportunity to play a game they have seen on a television game show.

Response to Arguments

11. Applicant's arguments with respect to claims 131-221 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Friday, 8:30 A.M. - 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael O'Neill, Acting SPE can be reached on (703) 308-1148. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

SEJ

sej
May 28, 2003



**MICHAEL O'NEILL
PRIMARY EXAMINER**